

**REMARKS**

The Office Action of March 9, 2005, has been carefully considered. Claims 1-34 are pending in the application. Claims 1-28, 30-34 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,412,428 to Tahara (hereinafter referred to as the Tahara reference). Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Tahara reference in view of an Official Notice.

In overview, by the present amendment, the rejections have been traversed in view of the following remarks. Claims 1, 11, 19, 26, and 30 have been amended. Claims 2, 3, 20, and 27 have been canceled. The Applicant respectfully requests reconsideration and allowance of the subject application. This Amendment is believed to be fully responsive to all issues raised in the Office Action dated March 9, 2005.

**Claim Rejections Under 35 USC §102**

Claims 1-28 and 30-34 were rejected under 35 U.S.C. §102(b) as being anticipated by the Tahara reference. In overview, in order for prior art to anticipate a claim under 35 U.S.C. §102 every element of the claimed invention must be identically disclosed either expressly or under principles of inherency in a single reference. Further, the exclusion of a claimed element from a prior art reference, no matter how insubstantial, is enough to negate anticipation by that reference. The test of whether anticipation exists in a particular case is a question of fact, and is applied element-by-element to a single prior art reference. Only if the prior art literally reads on every element of the rejected claim will the claimed invention be anticipated under this test.

1 With this in mind, the Applicant analyzes the §102 rejection of the claims in  
2 the present application. Independent Claim 1 has been amended to recite “wherein  
3 the enhanced information stream is selectively encoded using spatial information  
4 obtained from processing of the base information stream or using a previous  
5 reference obtained during processing of the enhanced information stream.”  
6 Independent Claims 11, 19, and 30 have been amended similarly. Independent  
7 Claim 26 has been amended to recite “wherein the enhanced decoder selectively  
8 decodes the enhanced information stream using spatial information obtained from  
9 processing of the base information stream or using a previous reference obtained  
10 during processing of the enhanced information stream.”

11 As discussed in the present application, spatial prediction provides a very  
12 efficient prediction method due to the high correlation between enhanced  
13 chrominance blocks in the enhanced stream and chrominance blocks in the base  
14 stream. Page 25, lines 20-22. This allows the color space coding framework of  
15 the present application to provide greater efficiency in prediction coding and  
16 results in a performance boost. Page 25, lines 22-24. The recited “selectively  
17 encoded” is performed via the mode selection switch 1158 illustrated in Figure 11.

18 Applicant disagrees with the Examiner’s contention that Figure 9C, 9B, and  
19 Figure 10 teach encoding the enhanced stream using spatial information related to  
20 the base information stream. The Applicant acknowledges that the same formats  
21 are discussed in the present application and the Tahara reference. In fact, the  
22 Applicant discusses those formats (Figures 1-5) in the background section of the  
23 present application. However, the Examiner fails to show where the Tahara  
24 reference teaches using spatial information related to the base information stream  
25 when encoding the enhanced information stream as recited in the rejected Claims.

1 Applicant further disagrees with the Examiner's contention that the mode  
2 selection 54 in Figure 11 teaches to selectively encode the enhanced information  
3 stream using spatial information related to the base information. In fact, upon  
4 closer inspection of the Tahara reference, the Applicant argues that the mode  
5 selecting circuit 54 does not teach selectively encoding the enhance information  
6 stream using spatial information but rather teaches selecting intra-frame or field  
7 prediction, forward prediction, backward prediction, or bidirectional prediction for  
8 circuit 100 that handles the lowest resolution color blocks. Col. 9, lines 22-26.  
9 Thus, the mode selecting circuit does not teach or suggest selectively encoding the  
10 enhanced information using spatial information related to the base information.  
11 Upon reviewing Figure 10 of the Tahara reference, one will notice that neither  
12 circuit 101 or 102 includes the ability to selectively encode using spatial  
13 information or using a previous reference as recited in Claim 1. In addition, upon  
14 an exhaustive review of the Tahara reference, the Applicant is unaware of any  
15 mention of selective encoding using spatial information as recited in the above  
16 independent claims.

17 Each of the dependent Claims 2-28 and 30-34, depends from either  
18 independent Claim 1, 11, 19, 26, or 30 and includes other limitations that are not  
19 taught or suggested by the Tahara reference. Therefore, for at least some of the  
20 above reasons, Applicant respectfully submits that the §102 rejections of Claims  
21 1-28 and 30-34 is improper, and respectfully requests reconsideration and  
22 withdrawal of this rejection.

### 23 **Claim Rejections Under 35 USC §103**

24 Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over  
25 the Tahara reference in view of Official Notice. For at least some of the reasons

1 that follow, Applicant respectfully disagrees that the subject matter of claim 29 is  
2 obvious over the Tahara reference in view of Official Notice.

3 In overview, as stated in MPEP § 2143, to establish a prima facie case of  
4 obviousness, three basic criteria must be met. First, there must be some  
5 suggestion or motivation, either in the references themselves or in the knowledge  
6 generally available to one of ordinary skill in the art, to modify the reference or to  
7 combine reference teachings. Second, there must be a reasonable expectation of  
8 success. Finally, the prior art reference (or references when combined) must teach  
9 or suggest all the claim limitations. The teaching or suggestion to make the  
10 claimed combination and the reasonable expectation of success must both be  
11 found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20  
12 USPQ2d 1438 (Fed. Cir. 1991).

13 Further, as stated in MPEP § 2143.01, obviousness can only be established  
14 by combining or modifying the teachings of the prior art to produce the claimed  
15 invention where there is some teaching, suggestion, or motivation to do so found  
16 either in the references themselves or in the knowledge generally available to one  
17 of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.  
18 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere  
19 fact that references can be combined or modified does not render the resultant  
20 combination obvious unless the prior art also suggests the desirability of the  
21 combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

22 Therefore, "all words in a claim must be considered in judging the  
23 patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165  
24 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35  
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1 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837  
2 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

3 Without repeating the arguments discussed above, the Applicant maintains  
4 that the Tahara reference does not teach or suggest a decoder that "selectively  
5 decodes the enhanced information stream using spatial information obtained from  
6 processing of the base information stream or using a previous reference obtained  
7 during processing of the enhanced information stream" as recited in Claim 29.

8 Therefore, the Applicant respectfully submits that the §103 rejections of  
9 Claim 29 is improper, and respectfully requests reconsideration and withdrawal of  
10 this rejection.

11 **Conclusion**

12 Applicant has considered the other references cited by the Examiner in the  
13 Office Action. None of these references appear to affect the patentability of  
14 Applicant's claims. By the foregoing remarks, Applicant believes that pending  
15 claims 1, 4-19, 21-26, and 28-34 are allowable and the application is in condition  
16 for allowance. Therefore, a Notice of Allowance is respectfully requested.  
17 Should the Examiner have any further issues regarding this application, the  
18 Examiner is requested to contact the undersigned attorney for the Applicant at the  
19 telephone number provided below.

20 Respectfully Submitted,

21  
22 Dated: 7/29/05

23 By: Marcia A. Tunheim  
24 Marcia A. Tunheim  
25 Reg. No. 42189  
(509) 324-9256